APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,484	09/07/2001	Wen-Sung Tsai	CEIP0027USA	4155

27765 7590 06/02/2005		EXAMINER
NORTH AMERICA INTERNATIONAL PATENT OFFICE (NAIPC)		NGUYEN, MAIKHANH
P.O. BOX 506		
MERRIFIELD, VA 22116	ART UNIT	PAPER NUMBER
	2176	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 November 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the following communication: Amendment filed 11/16/2004

original application filed 09/07/2001.

2.   Claims 1-17 are currently pending in this application. Claims 9-17 have been added.

Claims 1 and 3-4 have been amended. Claims 1 and 10 are independent claims

Priority

3.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d), and based on application # 090107623 filed in Taiwan on 03/30/2001,

which papers have been placed of record in the file.

Claim Objections

4.   Claim 1 is objected to because of the following informalities: the **abbreviation** used in

this claim (PDA) should be defined. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the
subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill
in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the
invention was made.

6.   Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant

Admitted Prior Art (APA) in view of **Mousseau et al.** (U.S. 6,477,529 – filed

12/1999).

As to independent claim 1:

a.   APA teaches *(Fig. 1)* a personal data assistant *(PDA 10; para.0006)* connected to a

server *(the computer 40; para.0007)*, the server having a plurality of application

programs *(the computer 40 comprises a plurality of application program 44;*

para.0007) the PDA comprising:

(i)   a housing *(a housing; para.0006)*;

(ii)   a memory installed in the housing for storing programs and data *(a*

memory 14 for storing application programs 16 and files 18; para.0007);

(iii)   a processor electrically connected to the memory for executing the

programs stored in the memory *(a processor 20 electronically connected*

to the memory 14 for executing the application programs 16; para.0007);

(iv)   a display panel installed on the housing for displaying data *(a display*

panel 22 installed on the housing 12; para.0006); and

(v)   an input device for inputting data *(an input device 24; para.0006)*;

the server then opening the file using a corresponding application program

(e.g., the file is opened by a corresponding application program 44;

para.0008).

b.   APA does teach the PDA is capable of sending a file through the wire 30, but

does not explicitly teach "sending a file to the server via network." Also, APA

does not explicitly teach "sending images generated by the opening file back to

the PDA."

c.   Mousseau teaches sending a file via the network and sending images generated by

the opening file back to the PDA *(col.7, lines 35-43).*

d.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to include the feature from Mousseau in the system of APA

because it would have provided the capability for downloading a necessary file to

a PDA from the host device connected via a communication network and

processing the download file (viewing, editing) by the PDA.

As to dependent claim 2:

APA teaches a data transceiving module, the file being sent from the data transceiving

module of the PDA to the data transceiving module of the server so that the server is

capable of opening the file *(para.0008).*

As to dependent claim 3:

APA teaches when the server opens the file, the server will transmit the images generated

by the opened file via the data transceiving module of the server to the data transceiving

module of the PDA so that the display panel is capable of displaying the images generated by the opened file *(para.0008)*.

As to dependent claim 4:

APA teaches the server opens the file, a user is capable of using the input device to enter a user instruction, the user instruction being transmitted from the data transceiving module of the PDA to the data transceiving module of the server so that the server is capable of executing the user instruction (para.0008). Refer to the claim 1 for "the server transmitting new images generated by the opened file generated by executing the user instruction to the data transceiving module of the PDA from the data transceiving module of the server so that the display panel is capable of displaying the new images generated by the opened file."

As to dependent claim 5:

APA teaches a user is capable of using the input device to enter a file back instruction, the file back instruction being transmitted from the data transceiving module of the PDA to the data transceiving module of the server, when receiving the file back instruction, the server transmitting the file back to the PDA via the data transceiving module of the server back and the data transceiving module of the PDA *(para.0006 and para.0008)*.

As to dependent claim 6:

APA teaches a user is capable of using the input device to enter a file close instruction, the file close instruction being transmitted from the data transceiving module of the PDA to the data transceiving module of the server so as to make the server close the file *(para.0006)*.

As to dependent claim 7:

a.   Mousseau teaches the network is an Internet *(an Internet; col.4, lines 26-41).*

b.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to include the feature from Mousseau in the system of APA

because it would have provided the capability for downloading a necessary file

from the host device connected via a communication network and immediately

carry out the process of the download file.

As to dependent claim 9:

a.   Mousseau teaches by using the input device, the images generated by the opened

filed can be edited on the display panel *(col.10, lines 3-9).*

b.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to include the feature from Mousseau in the system of APA

because it would have provided the capability for improving the performance of a

the PDA since it does not need to install a program in its memory for opening

files.

As to independent claim 10:

a.   The rejection of claim 1 above is incorporated herein in full. Additionally, APA

further teaches:

      (i)   uploading a file from PDA to the server *(upload the files to the PC;*

para.0005);

> (ii)   the server opening the file utilizing an appropriate application software
>
> stored on the server (*the user must open/edit the file by a corresponding*
>
> *application programs 44 in the computer 40*); and
>
> (iii)   downloading the file form the server to the PDA (*downloads the updated*
>
> *file from the computer 40 back to the PDA; para.0008*).

b.   APA, however, does not specifically teach editing the file on the display panel

utilizing a user input device comprised by the PDA.

c.   Mousseau teaches editing the file on the display panel utilizing a user input device

comprised by the PDA (*a handheld device configured to receive a document*

transmitted from the document server, the handheld device being further

configured to edit selected portions of the document in response to user input;

col.10, lines 3-9).

d.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to include the feature from Mousseau in the system of APA

because it would have provided the capability for improving the performance of a

the PDA since it does not need to install a program in its memory for opening

files.

As to dependent claims 11-13:

They include the same limitations as in claims 2-4, and are similarly rejected under the

same rationale.

As to dependent claim 14:

APA teaches the user instruction is a file editing command (*para.0008*).

As to dependent claims 15-16:

They include the same limitations as in claims 5-6, and are similarly rejected under the

same rationale.

7.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant

Admitted Prior Art (APA) in view of **Mousseau** and further in view of **Jakobson** (U.S.

6,697,838 – filed 03/1998).

As to dependent claim 8:

a.   The combination of APA and Mousseau does not explicitly teach "the memory is

        a flash memory."

b.   Jakobson teaches the memory is a flash memory (*flash memory; col.5, lines 50-*

        56).

c.   It would have obvious to a person of ordinary skill in the art at the time the

        invention was made to combine Jakobson' s teachings in the system of APA as

        modified by Mousseau because it would have provided the capability for storing

        data, more particularly, for enabling the PDA to support new protocols as they

        become standardized.

Response to Arguments

8.   Applicant's arguments filed 11/16/2004 have been fully considered but they are not

persuasive.

a.   Applicant argues that *Neither the APA nor any the other references cited by the Examiner as pertinent to patentability, alone or in combination, disclose or suggest the claimed above recited features of the present applicant.* (Remarks, page 9, 1st full para.)

b.   In response, the combination of APA, Mousseau, and Jakobson meets the limitations as claimed by Applicant.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Suzuki   U.S. Patent No. 6,493,743   issued: Dec. 10, 2002

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
May 31, 2005

WILLIAM BASHORE
PRIMARY EXAMINER
May 31, 2005